

Attorney Docket No. PC9517H
Application No. 10/615,282

Remarks

Amendments to the Claims

Entry of the above amendments is respectfully requested. Claims 1- 22 have been canceled by this amendment. New claims 23-26 have been added. New claims 23-26 are supported by original claims 1-4 and in the specification. New claims 23-26 are limited to a method of inhibiting irritable bowel syndrome with a compound of formula I or compounds within formula I. Applicants submit that no new matter has been introduced by these amendments.

Double Patenting Rejections

Claims 1-3 and 11 have been rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-3 of U.S. Patent No. 6,403,611. Claims 1-3 have been rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 3-5 of U.S. Patent No. 6,613,796. Instant claims 1-3 and 11 have been canceled by this amendment. Applicants respectfully submit that new claims 23-26 are directed to a method of inhibiting irritable bowel syndrome with compounds of formula I or other compounds within that genus and do not claim the same invention as either of U.S. Patent Nos. 6,403,611 or 6,613,796. Applicants respectfully request the Examiner to reconsider and withdraw the double patenting rejection in view of the amendment to the claims.

Claims 1-4 have been rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Patent No. 6,107,331 and claims 1-4 of U.S. Patent No. 6,911,456. Claims 1-3 and 5 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-4 of U.S. Patent No. 6,274,618. Claims 1-5 have been canceled by this amendment. New claims 23-26 pertain to a method inhibiting irritable bowel syndrome with a compound of formula I. Applicants respectfully submit that the claimed method is not obvious in view of methods of treating breast disorders, vaginal atrophy or breast cancers as claimed in U.S. Patent Nos. 6,107,331; 6,911, 456 or 6,274,618. Applicants respectfully request the Examiner to reconsider and withdraw the obviousness-type double patenting rejection in view of the amendment to the claims.

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35 U.S.C. § 112, First Paragraph

Claims 1-22 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly not being enabled. Claims 1-22 have been canceled by this amendment. The claims, as amended, now recite a method of inhibiting irritable bowel syndrome with a compound of formula I, or compounds within that genus. Applicants respectfully submit that the instant claims, as amended, are fully enabled such that one skilled in the art could employ the compounds of formula I in inhibiting irritable bowel syndrome in a patient in need thereof. The specification provides for various dosages, dosage regimens, pharmaceutical compositions and methods of administration for the compounds of formula I. One of ordinary skill in the art would clearly be enabled by the guidance provided in the specification to use a compound of formula I for inhibiting irritable bowel syndrome in a patient in need thereof by following the direction provided in the specification. Applicants respectfully submit that undue experimentation would not be required in view of the direction provided in the instant specification, particularly in the detailed description of the invention section.

For this reason, applicants respectfully request the Examiner to reconsider and withdraw the 35 U.S.C. § 112, first paragraph rejection in view of the amendments to the claims.

35 U.S.C. § 102(b)

Claims 1-4 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Cameron et al., U.S. Patent 5,552,412, (hereinafter Cameron). Cameron discloses a method of treating or preventing breast cancer with a compound of formula I.

Claims 1-4 have been canceled by this amendment. New claims 23-26 recite a method of inhibiting irritable bowel syndrome with a compound of formula I, or other compounds within that genus. Applicants respectfully submit that the method of treating or preventing breast cancer as taught by Cameron does not anticipate the method of inhibiting irritable bowel syndrome as presently claimed. For this reason, applicants respectfully request the Examiner to reconsider and withdraw the 35 U.S.C. § 102(b) rejection in view of the amendments to the claims.

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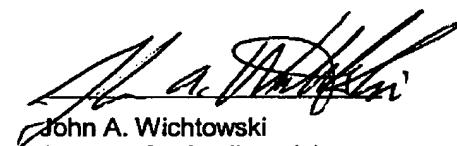
Conclusion

Applicants believe that, in view of the amendments to the claims and the remarks made above, this application is in condition for allowance. Entry of the amendments to the claims and reconsideration and allowance of claims 23-26, as amended, is respectfully requested.

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